

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DARRELL D. GOACHER SR.

Appeal No. 2004-1319
Application 09/933,329

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 16, 18 and 19. Claims 20 and 21 have been canceled. Claim 17, the only other claim remaining in the application, stands withdrawn from further consideration as being directed to a non-elected invention.

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Appellant's invention relates to a wire connector fastening tool and method of using such a fastening tool to connect a plurality of wires to one another via a conventional wire connector of the type seen in Figures 5-7 of the present application. Independent claims 1, 10 and 18 are representative of the subject matter on appeal, and a copy of those claims can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the claims before us on appeal are:

Moore	4,461,194	Jul. 24, 1984
Givot	4,860,618	Aug. 29, 1989
Jore	5,309,799	May 10, 1994
Fuca	5,542,321	Aug. 6, 1996
Lassiter	5,974,916	Nov. 2, 1999
Parker et al. (Parker)	6,053,078	Apr. 25, 2000
Rosenbaum	6,257,099B1	Jul. 10, 2001

Claims 1 through 8, 10 through 14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fuca in view of Parker or Rosenbaum.

Claims 9 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fuca in view of Parker or Rosenbaum as

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applied to claims 1 and 10 above, and further in view of Moore or Jore.

Claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lassiter in view of Givot.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we refer to the examiner's answer (Paper No. 16, mailed September 5, 2003) for an exposition of the examiner's positions, and to appellant's brief (Paper No. 15, filed July 22, 2003) for the arguments thereagainst.

OPINION

Having carefully reviewed the obviousness rejections raised in this appeal in light of the record before us, we have made the determinations which follow.

Looking first to the examiner's rejection of claims 1 through 8, 10 through 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Fuca in view of Parker or Rosenbaum, we note

that it is now clear from the comments on pages 4 and 5 of the answer (Paper No. 16) that the examiner is of the opinion that Fuca discloses a wrench or fastening tool (10) meeting all of the requirements of representative independent claim 1, except that mandating the body of the tool to have "an outer hand-engaging surface with a uniform outside diameter from its first end to its second end." The examiner also points to the requirements in dependent claims 5 and 6 regarding flutes on the outer hand-engaging surface extending from the first end to the second end of the body, and the requirement of dependent claim 7 that the body be formed of a polymeric material, noting that such features are not taught or suggested in Fuca. To account for the above-noted differences, the examiner looks to the teachings of Parker or Rosenbaum, contending that these patents each suggest that a hand-held tool can have flutes along a uniform diameter outer hand-engaging surface of a wrench body and that such a tool can be formed of polymeric material. Based on the collective teachings of Fuca and Parker, or Fuca and Rosenbaum, the examiner has now concluded that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to modify the tool of Fuca by providing it with a body having a uniform outer diameter hand-engaging surface and flutes extending

along the uniform diameter outer surface so as to enhance the grip of a user when the outer surface of the tool is to be manually gripped as taught or suggested in Parker or Rosenbaum, and to also make the wrench of Fuca from a polymeric material as suggested in either Parker or Rosenbaum.

On page 10 of the brief, appellant has denominated claims 1 through 8, 10 through 14 and 16 as constituting issue A, and specifically indicated that such claims "stand or fall together with respect to issue A." Accordingly, we have selected claim 1 as being representative of issue A, and will decide the appeal with regard to the claims listed under issue A on the basis of claim 1 alone. Claims 2 through 8, 10 through 14 and 16 will thus stand or fall with claim 1.

Concerning independent claim 1, appellant argues the examiner's two alternative rejections noted above separately. On pages 12 and 13 of the brief, appellant argues the § 103 rejection based on Fuca in view of Parker. In particular, appellant points out that Fuca does not disclose, teach or suggest a tool having "a uniform outside diameter from its first end to its second end," and contends that Parker fails to make up

for the shortcomings of Fuca. More specifically, appellant contends that Parker does not disclose, teach or suggest a tool having a body with an "outer hand-engaging surface" that has "a uniform outside diameter from one end to the other" and that the examiner has therefore failed to make out a *prima facie* case of obviousness because Fuca and Parker fail to disclose all features of the claimed invention. In appellant's view the device of Parker has three distinct sections, 1) the top part of the "T"; 2) the bottom part of the "T"; and 3) the "working end" of the wrench (20), which appellant urges is not itself engaged manually by the user.

We do not find appellant's above-noted arguments persuasive of error in the examiner's rejection of claim 1 on appeal under 35 U.S.C. § 103(a) based on Fuca in view of Parker. Like the examiner, we observe that appellant has apparently failed to appreciate the features of the wrench (20) shown in Figures 2A-2D of Parker and the disclosure in Parker at column 3, lines 17-22, concerning use of the wrench (20) "alone by gripping it manually," and the disclosure at column 3, lines 29-34, of providing the cylindrical outer side surface (30) of the wrench (20) with flutes (32) to facilitate gripping the wrench when it

is used alone. While the wrench (20) of Parker can also optionally be used in conjunction with a detachable, existing T-handle spike wrench like that seen in Figure 4A, the T-handle is clearly not part of the wrench (20) and is not required to be used with the wrench (20). Thus, appellant's arguments concerning the purported failings of Parker and the failure of the combined disclosures of Fuca and Parker to disclose all features of the claimed invention are in error and not persuasive.

In light of the foregoing, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103(a) based on Fuca in view of Parker. As for claims 2 through 8, 10 through 14 and 16, also rejected by the examiner under 35 U.S.C. § 103(a) based on the collective teachings of Fuca and Parker, given appellant's grouping of claims set forth on page 10 of the brief, it is our determination that those claims will fall with independent claim 1.

As for the examiner's rejection of claims 1 through 8, 10 through 14 and 16 under 35 U.S.C. § 103(a) based on Fuca in view of Rosenbaum, we note appellants' arguments on pages 13-16 of the

brief. In contesting this rejection, appellant urges that the examiner has engaged in hindsight reconstruction of the claimed invention by improperly taking appellant's own disclosure as a blueprint for selectively piecing together the applied prior art to defeat patentability. After careful consideration of the disclosures of Fuca and Rosenbaum, we agree with appellant.

More specifically, we observe that Fuca touts the extremely simple construction of the basin wrench seen therein, and the fact that the double-ended wrench depicted in Figure 2 is inexpensively constructed of two lengths of steel pipe defining wrench end portions (25) and (26), wherein the two lengths of pipe are of different outside and inside diameters and are joined together by being "telescoped together near adjacent ends and then . . . welded to one another at 27" (col. 2, lines 46-48). As seen in Figures 2 and 5-8, the two different diameter pipe sections provide the basin wrench (10) of Fuca with a larger end portion (25) and a smaller end portion (26), wherein the different size end portions are adapted to cooperate with different size and configuration nuts (18, 18A, 18B and 18C). By contrast, Rosenbaum discloses a multi-function faucet wrench molded out of a suitable plastic material (col. 3, lines 20-21)

and including a uniform outside diameter elongate body member (2) with a nut receiving socket (3) at one end, a fluted handgrip portion (5) adjacent the other end, and a longitudinal bore (17) extending through the body member.

Like appellant, we find nothing in either Fuca or Rosenbaum regarding a teaching or suggestion that would have motivated one of ordinary skill in the art at the time appellant's invention was made to selectively combine the features of the two wrenches in the particular manner posited by the examiner. In that regard, we note that the mere fact that the prior art could be modified in the manner urged by the examiner would not have made such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). In this case, it is our opinion that the prior art does not contain such a suggestion and that the examiner has impermissibly drawn from appellant's own teaching and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." W.L. Gore &

Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Simply stated, there is no reason or suggestion in the applied prior art for making the wrench of Fuca with a uniform outside diameter from its first end to its second end, as specified in independent claims 1 and 10 on appeal. Moreover, given the disclosure of Fuca concerning the simplicity and economy of construction of the wrench therein and use of the different diameter end portions (25, 26) to accommodate different size and configuration nuts, there would appear to be little or no incentive for making such a modification therein.

Since we have determined that the teachings and suggestions which would have been fairly derived from Fuca and Rosenbaum would not have made the subject matter as a whole of independent claims 1 and 10 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of claims 1 and 10, and the claims which depend therefrom, under 35 U.S.C. § 103(a). Thus, the examiner's rejection of claims 1 through 8, 10 through 14 and 16 under 35 U.S.C. § 103(a) based on Fuca and Rosenbaum will not be sustained.

We have also reviewed the patents to Moore and Jore applied along with Fuca and Rosenbaum against dependent claims 9 and 15 on appeal under 35 U.S.C. § 103(a). However, we find nothing in Moore or Jore which overcomes the deficiencies in the basic combination of Fuca and Rosenbaum noted above or otherwise renders obvious the wire connector fastening tool set forth in claims 1 and 10 on appeal or in claims 9 and 15 which depend therefrom. Thus, the examiner's rejection of dependent claims 9 and 15 under 35 U.S.C. § 103(a) based on Fuca in view of Rosenbaum and Moore or Jore will likewise not be sustained.

However, we reach a contrary conclusion with regard to the examiner's rejection of dependent claims 9 and 15 under 35 U.S.C. § 103(a) based on Fuca in view of Parker and Moore or Jore. On pages 16-17 of the brief, appellant appears to concede that Moore and/or Jore suggests the use of transparent material for allowing viewing of some interior part of the tool, as the examiner has urged on pages 4-5 of the answer, and thus acquiesced in this aspect of the examiner's rejection. What appellant contends regarding the examiner's rejection of claims 9 and 15 is that neither Moore nor Jore makes up for that which appellant views as lacking in the combined disclosures of Fuca and Parker, i.e., a

wrench with a uniform outside diameter from its first end to its second end. For the same reasons set forth above in our discussion of the rejection of independent claim 1 based on Fuca and Parker, we again find this argument to be unpersuasive. Accordingly, the examiner's rejection of dependent claims 9 and 15 under 35 U.S.C. § 103(a) based on Fuca in view of Parker and Moore or Jore will be sustained.

The next rejection for our review is that of method claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Lassiter in view of Givot. In this instance, the examiner has determined (answer, page 3) that Lassiter shows or discloses the claimed invention (e.g., in Figs. 4-10) except for the step of turning the elongate body of the tool by manually gripping the outer surface (59) of the tool to provide rotational torque to both the tool and wire nut connector necessary for securing a wire connector to the conducive ends of electrical wires. However, the examiner finds in Givot a teaching/suggestion of a wire nut fastening tool (e.g., Fig. 1) having an outer cylindrical surface with appropriate gripping areas that facilitate manual gripping of the fastening tool (col. 3, lines 17-19) to apply the torque necessary for securing a wire

connector to the conducive ends of electrical wires. Givot also shows (e.g., in Fig. 3) an embodiment of a wire nut fastening tool incorporating both a manual gripping feature and a ratchet mechanism (20) which can alternatively be used to apply the necessary torque to the tool. From the combined teachings of Lassiter and Givot, the examiner has concluded that it would have been obvious to one of ordinary skill in the art at the time appellant's invention was made to modify the tool of Lassiter to facilitate use of the wire connector fastening tool therein by manually gripping the outer surface of the tool to apply the torque necessary for securing a wire connector to the conducive ends of electrical wires, because Givot suggests use of such direct manual gripping of the outer surface of the tool as an alternative to using the ratchet mechanism associated with the tool for applying the necessary torque, if so desired.

We agree with the examiner. Appellant's argument (brief, page 19) that the body of Givot's tool could not be extruded and cut to length, as described in appellant's specification, is of no avail, since neither of claims 18 and 19 on appeal contain any such requirement. As for appellant's assertion (brief, page 20) that the examiner has not provided any specific reason why one of

ordinary skill in the art would have been motivated to combine the Lassiter and Givot references, we find such argument equally unavailing since the examiner has clearly set forth a reason, based on teachings found in Givot, for using direct manual gripping of the outer surface of the tool in Lassiter as an alternative to using the ratchet mechanism associated with the tool for applying the torque necessary for securing a wire connector to the conducive ends of electrical wires.

In light of the foregoing, we will sustain the examiner's rejection of claims 18 and 19 under 35 U.S.C. § 103(a) as being obvious over the collective teachings of Lassiter and Givot.

Since at least one of the examiner's rejections has been sustained with regard to each of the claims before us on appeal, it follows that the decision of the examiner is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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Thompson Coburn, LLP
One US Bank Plaza
Suite 3500
St. Louis, MO 63101